

REMARKS/ARGUMENTS

Claim Rejections – 35 USC §103

Claims 1-10 and 33 stand rejected under 35 USC §103(a) as being unpatentable over De Luca et al. (US 6,410,119) in view of Jostler et al. (US 5,693,163).

As more fully discussed in Applicants' previous responses, De Luca is directed to a bubble wrap product having an inflation channel 31 that is bounded by first and second film sheets of a web 11 and defined between spaced-apart seal lines 33 and 35. Seal line 33 extends along one of the outermost longitudinal edges of the web while seal line 35 extends parallel to and inboard of seal line 33 (see FIG. 1). Thus, the two seal lines 33 and 35 join the first and second film sheets of web 11 together such that inflation channel 31 is bounded by the first and second film sheets with a width (when uninflated) or diameter (when inflated) that is defined by the spacing between the pair of seal lines 33 and 35.

In contrast, the claimed inflatable web employs a pair of longitudinal flanges that are open, i.e., not sealed together, at an outermost longitudinal edge of the web. Therefore, the flanges do not form a channel bounded on all sides as taught in De Luca, wherein the outer edge of the channel is sealed closed by seal line 33. This feature was previously clarified by amending claim 1 to specify that the "flanges hav[e] a pair of open, unsealed edges."

In the current Office Action, Jostler is cited in combination with De Luca in an attempt to cure the deficiency of the De Luca reference, namely, the failure of such reference to disclose flanges having a pair of open, unsealed edges. The Examiner argues that Jostler teaches that it is old and well-known in the analogous art to have flanges having a pair

of open, unsealed edges, citing FIG. 1a, reference numeral 24a, b; also col. 2, lines 39-45, wherein Jostler teaches that each “respective wall 21a, b includes two opposing edge portions 24a, b which extend in the longitudinal direction of the web....” The Examiner concludes that, because the open edges are provided “for the purpose of filling the pockets (chambers) with some material in order to inflate them ... it would have been obvious ... to have modified the longitudinal flanges in De Luca et al. to have a pair of open, unsealed edges as suggested by Jostler et al. in order to inflate the chambers....” (Part 4 of 12/14/2004 Office Action.)

In response, Applicants contend that, when the Jostler and De Luca references are read as whole, they are not properly combinable in the manner suggested by the Examiner, and thus do not establish a *prima facie* case of obviousness.

Jostler discloses a web 20 of flexible material, comprising a series of package-blanks/pockets 26 (col. 2, lines 8-18). The pockets are formed between opposing walls 21a, b. Each wall 21a, b includes two opposing edge portions 24a, b, which extend in the longitudinal direction of the web and include continuous retainer devices 43a, b for cooperation with mechanical devices 33a, b to supply material to be packaged into the pockets 26 (col. 2, lines 39-45). As shown in FIG. 3, such material is supplied into the pockets 26 at a filling station 3, wherein the mechanical devices 33a, b hold the edge portions 24a, b apart via retainer devices 43a, b (col. 3, lines 29-36).

Transverse slots 27 or transverse perforations 78 form separation means between each container. Longitudinal slots 29 extend from each transverse slot 27 and into each of the pockets 26. Similarly, longitudinal perforations 79 extend from each transverse perforation 78 and into each of the pockets 26. The function of the longitudinal slots

29/perforations 79 is to facilitate the opening of the pockets 26 during the filling thereof in filling station 3 (col. 3, lines 30-50).

MPEP §2143 sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness. **First**, there must be some suggestion or motivation in the prior art to combine the teachings of the references. **Second**, there must be a reasonable expectation of success. An important proviso is that the suggestion to make the claimed combination must be found in the prior art, and not in the applicant's application. *MPEP §2143* (Eighth Edition, August 2001; Rev. 2, May 2004).

Turning to the first requirement of MPEP §2143, Jostler provides absolutely no teaching or suggestion of inflatable webs as disclosed in De Luca. More specifically, Jostler does not teach or suggest that pockets 26 are inflated with air to make inflatable cushioning material for protecting objects packaged within a shipping container as taught in De Luca (see, e.g., De Luca at col. 2k, lines 37-46). Instead, Jostler teaches that pockets 26 form packages that are filled with material (see, e.g., claim 9). Moreover, the longitudinal slots/perforations 29, 79 extend into the pockets 26. Accordingly, it would be difficult, if not impossible, to inflate the pockets 26. Thus, far from suggesting the use of opposing longitudinal edge portions 24a, b in an inflatable web such as De Luca's, Jostler's teaching of longitudinal slots/perforations 29, 79 in the pockets 26 teaches away from applying longitudinal edge portions 24a, b to an inflatable web because such slots/perforations would prevent inflation of the pockets, yet are taught to be a necessary complement to such longitudinal edge portions in order to displace the edges and continuous retainer devices 43a, b thereof sufficiently to introduce contents to be packaged into the pockets (col. 3, lines 30-50).

With regard to the second requirement of MPEP §2143, it is well-established that a proposed modification of prior art references cannot render the prior art unsatisfactory for its intended purpose, and cannot change the principle of operation of a reference. *MPEP §2143.01* (Eighth Edition, August 2001; Rev. 2, May 2004). In the instant case, the proposed modification of De Luca based on Jostler would contravene both of the foregoing principles.

At col. 5, lines 52-58, De Luca specifies that the

inflation channel 31 is defined between spaced apart seal lines 33 and 35.

The seal line 33 is opened at spaced intervals to provide outlet ports 37. The outlet ports 37 function to permit a certain amount of the inflation pressure in the inflation channel 31 to be vented to atmosphere.

As explained at col. 6, lines 51-55,

[t]he outlet ports 37 ... serve to regulate the level of the air pressure within the inflation channel 31 (as described in more detail in co-pending application Ser. No. 09/638,843 incorporated by reference in this application).

In addition to regulating the level of air pressure within the inflation channel, the outlet ports 37 also facilitate accurate position sensing of the individual inflatable strips 21 by sensing escaping air from the outlet ports via a pressure transducer (paragraph bridging cols. 5-6).

If De Luca's inflation channel were modified by changing the enclosed channel into a pair of flanges having open, unsealed edges as proposed in the Office Action, seal line 33 at the outermost edge of inflation channel 31 would have to be removed, thereby eliminating the outlet ports 37 (see FIGS. 1 and 2). Such a modification would render the De Luca web unsatisfactory for its intended purpose because the outlet ports 37 would no longer be present "to regulate the level of the air

pressure within the inflation channel 31" (col. 6, lines 51-55), or to allow escaping air from the outlet ports to be sensed by a pressure transducer (paragraph bridging cols. 5-6).

Moreover, converting the enclosed inflation channel 31 to a pair of unsealed flanges would completely change the principle of operation of the De Luca invention. As explained hereinabove, De Luca inflates each of the inflatable strips 21 indirectly by first inflating the inflation channel 31 with pressurized air. The inflated channel then directs the pressurized air into the entrance ports 41 of each of the inflatable strips (col. 6, lines 5-10). Col. 6, lines 45-50 further explains that

[a]n outlet bulb 57 of an inflation tube 59 is positioned within the inflation channel 31 and introduces air under pressure into the inflation channel for inflating the individual inflatable strips 21 by causing pressurized air to flow through the entrance ports 41.

If De Luca's inflation channel were modified by changing the enclosed channel into a pair of flanges having open, unsealed edges as proposed in the Office Action, the resultant flange-edge would no longer be capable of maintaining itself in an inflated state to direct pressurized air into the inflatable strips 21, thereby radically changing De Luca's principle of operation.

Accordingly, when the De Luca and Jostler references are read as a whole and without resort to hindsight reconstruction based on Applicants' disclosure, it is clear that the proposed combination thereof lacks both a motivational basis and an expectation of success. Under MPEP §2143, therefore, such combination does not constitute a *prima facie* case of obviousness against the presently claimed invention.

For all of the foregoing reasons, Applicants respectfully submit that the claims as presently presented are patentably distinct from the

applied references and in condition for allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,



Thomas C. Lagaly
Attorney for Applicants
Registration No. 34,652

P.O. Box 464
Duncan, SC 29334
(864) 433-2333

APRIL 11, 2005
Date